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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,625	01/10/2005	Masayuki Kamite	264121US3PCT	5601

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EXAMINER	
LEYSON, JOSEPH S	
ART UNIT	**PAPER NUMBER**
1722	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/520,625	KAMITE, MASAYUKI	
	Examiner	Art Unit	
	Joseph Leyson	1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-15* is/are rejected.

7)☒ Claim(s) *10-15* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 January 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. All previous objections and/or rejections are withdrawn in view of Applicant's response filed on September 27, 2006, if NOT restated below.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Figure 6 only shows two members designated by reference character "103" of the three members including a magnet, an eddy current separator and a gravity separator. Therefore, the missing third member must be shown (or properly labeled) or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. No new matter should be added.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "103" has been used to designate a magnet, an eddy current separator and a gravity separator, i.e. all three members should have different reference characters.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. No new matter should be added.

Specification

4. The disclosure is objected to because of the following informalities: the specification (i.e., pp. 32-36) uses reference character "103" to designate a magnet, an eddy current separator and a gravity separator. All three members should have different reference characters.

Appropriate correction is required.

Claim Objections

5. Claims 10-15 are objected to because of the following informalities: for proper idiomatic language,

in claim 10, line 2, "the" should be changed to --a--;

in claim 11, line 2, "the" should be changed to --a--;

in claim 12, line 2, "the" should be changed to --a--; and line 8, "have" should be changed to --has--;

in claim 13, line 2, "the" should be changed to --a--; and line 8, "have" should be changed to --has--;

in claim 14, line 2, "the" should be changed to --a--; line 8, "have" should be changed to --has--; and line 11, "is" should be deleted; and

in claim 15, line 2, "the" should be changed to --a--; line 8, "have" should be changed to --has--; and line 12, "is" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafsson (U.S. Patent 5,746,958) in view of Barnes (U.S. Patent 3,538,595).

Gustafsson (U.S. Patent 5,746,958) discloses a manufacturing apparatus to manufacture a wood-like molded product through extrusion molding, the apparatus including a first crushing device 30B to crush or pulverize a resin waste material, a second crushing device 30A to crush or pulverize a wood waste material, a magnet to separate metals (i.e., col. 5, lines 17-21), a blending mixer 40, 100 to mix the crushed resin waste material and the crushed wood waste material to prepare a mixed material, an extrusion molding device 70 to heat and melt the mixed material, and mold the mixed material into an extrusion mold product through extrusion molding, and a sizer member 95. However, Gustafsson (U.S. Patent 5,746,958) does not disclose the extrusion molding device molding the material into a cylindrical shape, the sizer member including an opening portion having an inner diameter which is substantially the same as an outer diameter of the extrusion mold product in the cylindrical shape produced by the extrusion molding device through the extrusion molding, or a cutting device to cut the extrusion mold product into a predetermined length.

Barnes (U.S. Patent 3,538,595) discloses a manufacturing apparatus to manufacture an extrusion mold product with a cylindrical main body through extrusion molding, the apparatus including an extrusion molding device 2 to heat and melt an extrusion material, and mold the material into a cylindrical shape 1 through extrusion molding, a sizer member 3, 6 which includes an opening portion of which an inner diameter is substantially the same as an outer diameter of an extrusion mold product 1 in the cylindrical shape produced by the extrusion molding device 2 through the extrusion molding, and adjusts a sectional shape and a dimension of the extrusion mold

product 1 by inserting the extrusion mold product 1 into the opening portion, and a cutting device 8 to cut the extrusion mold product 1, of which the sectional shape and the dimension are adjusted by the sizer member 3, 6, into a predetermined length, thus forming the cylindrical main body.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the apparatus of Gustafsson (U.S. Patent 5,746,958) such that the extrusion molding device molds the mixed material into a cylindrical shape, that the sizer member includes an opening portion having an inner diameter which is substantially the same as an outer diameter of the extrusion mold product in the cylindrical shape produced by the extrusion molding device through the extrusion molding, and that a cutting device to cut the extrusion mold product into a predetermined length is further included because such a modification would provide an extrusion mold product with a cylindrical shape which was cut to a predetermined length, as disclosed by Barnes (U.S. Patent 3,538,595). Note that it is well known and conventional in the extrusion art to extrude cylindrical shapes, i.e., pipes, to size or calibrate the cylindrical shapes, and to cut the cylindrical shapes to length, as disclosed by Barnes (U.S. Patent 3,538,595).

8. Claim 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafsson (U.S. Patent 5,746,958) in view of Barnes (U.S. Patent 3,538,595) as applied to claims 10 and 12 above, and further in view of Taguchi et al. (U.S. Patent 6,228,301).

Gustafsson (U.S. Patent 5,746,958) and Barnes (U.S. Patent 3,538,595) disclose the apparatus substantially as claimed, except for a third crushing device to further crush the crushed wood waste material crushed by the second crushing device, to produce fine chips, and a grinding device to grind the fine chips into a fine powder.

Taguchi et al. (U.S. Patent 6,228,301) discloses a manufacturing apparatus to manufacture a wood-like molded product through extrusion molding, the apparatus including pulverizing equipment including a second crushing machine to crush a wood waste material (i.e., col. 8, lines 1-16), , a third crushing device to further crush the crushed wood waste material crushed by the second crushing device, to produce fine chips (i.e., col. 8, lines 17-32), and a grinding device to grind the fine chips into a fine powder (i.e., col. 8, lines 33-56), a blending mixer to mix crushed resin waste material and the crushed wood waste material to prepare a mixed material (i.e., col. 8, lines 63-67), and an extrusion molding device (col. 9, lines 1-4).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the apparatus with a third crushing device to further crush the crushed wood waste material crushed by the second crushing device, to produce fine chips, and a grinding device to grind the fine chips into a fine powder because such a modification would enable the wood waste material to be pulverized in a three step process which effectively pulverizes the wood waste material from lumps to fine powdery particles, as disclosed by Taguchi et al. (U.S. Patent 6,228,301: i.e., col. 7, line 60, to col. 8, lines 62).

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafsson (U.S. Patent 5,746,958) in view of Barnes (U.S. Patent 3,538,595) as applied to claims 10 and 12 above, and further in view of Hayashi et al. (U.S. Patent 5,301,881).

Gustafsson (U.S. Patent 5,746,958) and Barnes (U.S. Patent 3,538,595) disclose the apparatus substantially as claimed, as mentioned above, except for an eddy current separator device and a gravity separator, as recited by instant claim 13.

Hayashi et al. (U.S. Patent 5,301,881) disclose a metal separating apparatus for separating metals from other materials, the apparatus including a magnetic sorter 10, an eddy current separator device 11 to separate a metal which is not attracted to the magnetic sorter but has conductivity, and a gravity separator 24 to separate a substance that is not separated by the magnetic sorter and the eddy current separator device. (i.e., fig. 2).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the apparatus with an eddy current separator device and a gravity separator, as recited by Hayashi et al. (U.S. Patent 5,301,881), because such a modification would remove other metals which were not removed by the magnet of Gustafsson (U.S. Patent 5,746,958) and because Gustafsson (U.S. Patent 5,746,958; col. 5, lines 17-21) discloses that removing metal fragments is desired because such metal fragments could cause equipment failure and result in costly repairs and downtime.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gustafsson (U.S. Patent 5,746,958) in view of Barnes (U.S. Patent 3,538,595) as applied to claims 10 and 12 above, and further in view of Hayashi et al. (U.S. Patent 5,301,881) and Taguchi et al. (U.S. Patent 6,228,301).

Gustafsson (U.S. Patent 5,746,958) and Barnes (U.S. Patent 3,538,595) disclose the apparatus substantially as claimed, as mentioned above, except for an eddy current separator device, a gravity separator, a third crushing device, and a grinding device, as recited by instant claim 15.

Taguchi et al. (U.S. Patent 6,228,301) discloses a manufacturing apparatus to manufacture a wood-like molded product through extrusion molding, the apparatus including pulverizing equipment including a second crushing machine to crush a wood waste material (i.e., col. 8, lines 1-16), , a third crushing device to further crush the crushed wood waste material crushed by the second crushing device, to produce fine chips (i.e., col. 8, lines 17-32), and a grinding device to grind the fine chips into a fine powder (i.e., col. 8, lines 33-56), a blending mixer to mix crushed resin waste material and the crushed wood waste material to prepare a mixed material (i.e., col. 8, lines 63-67), and an extrusion molding device (col. 9, lines 1-4).

Hayashi et al. (U.S. Patent 5,301,881) disclose a metal separating apparatus for separating metals from other materials, the apparatus including a magnetic sorter 10, an eddy current separator device 11 to separate a metal which is not attracted to the magnetic sorter but has conductivity, and a gravity separator 24 to separate a

substance that is not separated by the magnetic sorter and the eddy current separator device. (i.e., fig. 2).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the apparatus with an eddy current separator device and a gravity separator, as recited by Hayashi et al. (U.S. Patent 5,301,881), because such a modification would remove other metals which were not removed by the magnet of Gustafsson (U.S. Patent 5,746,958) and because Gustafsson (U.S. Patent 5,746,958; col. 5, lines 17-21) discloses that removing metal fragments is desired because such metal fragments could cause equipment failure and result in costly repairs and downtime; and to further modify the apparatus with a third crushing device to further crush the crushed wood waste material crushed by the second crushing device, to produce fine chips, and a grinding device to grind the fine chips into a fine powder because such a modification would enable the wood waste material to be pulverized in a three step process which effectively pulverizes the wood waste material from lumps to fine powdery particles, as disclosed by Taguchi et al. (U.S. Patent 6,228,301: i.e., col. 7, line 60, to col. 8, lines 62).

Double Patenting

11. Claims 10-15 of this application conflict with claim 6 of Application No. 11/481,790. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either

cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Application No. 11/481,790 is a divisional application of this application. The examiner suggests canceling claim 6 of Application No. 11/481,790 because claim 6 is drawn to the invention (i.e., apparatus) elected for prosecution is this application.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 10 and 12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 11/481,790 in view of Gustafsson (U.S. Patent 5,746,958).

Claim 6 of copending Application No. 11/481,790 discloses the apparatus substantially as claimed, except for a first crushing device, a second crushing device, a magnet, or a blending mixer, as recited by claims 10 and 12. Gustafsson (U.S. Patent

5,746,958) is discussed above. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the apparatus of claim 6 of copending Application No. 11/481,790 with a first crushing device, a second crushing device, a magnet, and a blending mixer because such a modification would enable the apparatus to recycle wood and thermoplastic waste into an extruded product, as disclosed by Gustafsson (U.S. Patent 5,746,958).

This is a provisional obviousness-type double patenting rejection.

14. Claim 11 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 11/481,790 in view of Gustafsson (U.S. Patent 5,746,958), as applied to claims 10 and 12 above, and further in view of Taguchi et al. (U.S. Patent 6,228,301).

Taguchi et al. (U.S. Patent 6,228,301) is discussed above. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the apparatus with a third crushing device to further crush the crushed wood waste material crushed by the second crushing device, to produce fine chips, and a grinding device to grind the fine chips into a fine powder because such a modification would enable the wood waste material to be pulverized in a three step process which effectively pulverizes the wood waste material from lumps to fine powdery particles, as disclosed by Taguchi et al. (U.S. Patent 6,228,301: i.e., col. 7, line 60, to col. 8, lines 62).

This is a provisional obviousness-type double patenting rejection.

15. Claim 13 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 11/481,790 in view of Gustafsson (U.S. Patent 5,746,958), as applied to claims 10 and 12 above, and further in view of Hayashi et al. (U.S. Patent 5,301,881).

Hayashi et al. (U.S. Patent 5,301,881) is discussed above. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the apparatus with an eddy current separator device and a gravity separator, as recited by Hayashi et al. (U.S. Patent 5,301,881), because such a modification would remove other metals which were not removed by the magnet of Gustafsson (U.S. Patent 5,746,958) and because Gustafsson (U.S. Patent 5,746,958; col. 5, lines 17-21) discloses that removing metal fragments is desired because such metal fragments could cause equipment failure and result in costly repairs and downtime.

This is a provisional obviousness-type double patenting rejection.

16. Claim 15 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of copending Application No. 11/481,790 in view of Gustafsson (U.S. Patent 5,746,958), as applied to claims 10 and 12 above, and further in view of Taguchi et al. (U.S. Patent 6,228,301) and Hayashi et al. (U.S. Patent 5,301,881).

Taguchi et al. (U.S. Patent 6,228,301) and Hayashi et al. (U.S. Patent 5,301,881) are discussed above. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the apparatus with a third crushing device to further crush the crushed wood waste material crushed by the second

crushing device, to produce fine chips, and a grinding device to grind the fine chips into a fine powder because such a modification would enable the wood waste material to be pulverized in a three step process which effectively pulverizes the wood waste material from lumps to fine powdery particles, as disclosed by Taguchi et al. (U.S. Patent 6,228,301: i.e., col. 7, line 60, to col. 8, lines 62), and to further modify the apparatus with an eddy current separator device and a gravity separator, as recited by Hayashi et al. (U.S. Patent 5,301,881), because such a modification would remove other metals which were not removed by the magnet of Gustafsson (U.S. Patent 5,746,958) and because Gustafsson (U.S. Patent 5,746,958; col. 5, lines 17-21) discloses that removing metal fragments is desired because such metal fragments could cause equipment failure and result in costly repairs and downtime.

This is a provisional obviousness-type double patenting rejection.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ozaki et al. (U.S. Patent Application Publication US 2004/0135282) and Ozaki et al. (U.S. Patent 7,128,858) both claim priority to an international application which was NOT printed in English and thus do NOT apply as 102(e) references. Dahl et al. (U.S. Patent 6,153,293), Brooks et al. (U.S. Patent 5,082,605) and Levasseur (U.S. Patent 4,968,463) are cited as of interest to show the state of the art.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Leyson whose telephone number is (571) 272-5061. The examiner can normally be reached on M-F 9AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gupta Yogendra can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

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12/11/06